

**REMARKS**

Claims 33-55 have been newly added. Support for newly added claims 33-55 can be found in the specification and canceled claims 1-6, 9-14, 20-25, and 28-32. This is a full and timely response to the outstanding non-final Office Action mailed January 29, 2004. Upon entry of the foregoing amendments in this response, claims 33-55 remain pending in the application. Claims 1-32 have been cancelled.

In the Office Action, claims 1-2, 4, 9-10, 12, 15-18, 20-21, 23, 28-29, and 31 stand rejected under 35 U.S.C. § 102(b). Claims 1-6, 9-18, 20-25, and 28-32 stand rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses all of the rejections of the office action. In the Office Action Summary of the above-referenced Office Action, the Office Action was marked as final. However, a telephone conversion on February 5, 2004 with Examiner Luong confirmed that this was a clerical error. The Office Action Summary should have indicated that the Office Action is non-final. Reconsideration and allowance of the application and presently pending claims 33-55 are respectfully requested.

**I. Response to Claim Rejections Based On Anticipation**

Claims 33-55 are not anticipated by U.S. Patent No. 4,534,126 to Gilman (hereafter, "Gilman").

As the examiner is aware, "Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention."

*Structural Rubber Products Co. v. Park Rubber Co.*, 749 F.2d 707, 223 USPQ 1264 (Fed.

HAYES SOLOWAY P.C.  
130 W. CUSHING ST.  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

Cir. 1984). Further, "Absence from a cited reference of any element of a claim of a patent negates anticipation of that claim by the reference." *Kloster Speed Steel AB v. Crucible, Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986), *on rehearing*, 231 USPQ 160 (Fed. Cir. 1986). Thus, even if a single element found in Applicant's claim is not identically and exactly disclosed in prior art relied upon by the Examiner, the Examiner's rejection of the claims under 35 USC § 102(b) is improper.

Applicants respectfully submit that the Gilman reference fails to disclose, teach, or suggest all elements of the new claims for the reasons that follow.

#### A. Claim 33

Newly added independent claim 33 reads:

A container for displaying an item comprising:

a first end cap comprising *a protrusion shape located within a rim of the first end cap* and a second end cap comprising *a protrusion shape located within a rim of the second end cap* both the first and second end cap having a cross section;

a central portion press fit coupled to the first and the second end caps;

a merchandising card comprising *a first end secured with the protrusion shape of the first end cap* and *a second end secured with the protrusion shape of the second end cap* and carrying graphics or indicia extending between and secured in position in the end caps *wherein the merchandising card detachably secures an item* between the first end and the second end.

*(Emphasis added).*

Applicants respectfully submit that the teachings of Gilman fail to disclose all aspects of the invention emphasized in the above claim. In particular, the teachings of Gilman fail to disclose a protrusion shape on both the first end cap and second end cap for securing a first and second end of the merchandising card, respectively.

HAYES SOLOWAY P.C.  
130 W. CUSHING ST.  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

Gilman discloses an end wall 25 that holds the advertising material 14 in place. This does not disclose protrusions for holding the merchandising card.

Additionally, Applicants respectfully submits that Gilman also fails to disclose the merchandising card detachably securing an item between the first end and the second end of the merchandising card. Gilman discloses a weight 15, which is not secured to the advertising material of Gilman. This does not disclose detachably securing an item for display between the first end and the second end of the merchandising card.

Therefore, since the teachings of Gilman fail to disclose all elements of independent claim 33, Applicant respectfully submits that independent claim 33 should be allowed.

**B. Claims 34-44**

Applicants respectfully submit that pending dependent claims 34-44 contain all features of the respective independent claim 33. Since independent claim 33 should be allowed, pending dependent claims 34-44 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**1. Claim 34**

In addition to the above mentioned, Gilman does not disclose that the transparent material comprises a thermoplastic.

Therefore, Applicants respectfully submit that claim 34 should be allowed.

**2. Claim 37**

In addition to the above mentioned, Gilman does not disclose protrusions on the end cap rims for engaging an opening in the end cap rims.

Therefore, Applicants respectfully submit that claim 37 should be allowed.

**3. Claim 39**

In addition to the above mentioned, Gilman does not disclose that each end cap rim further comprises a groove for accepting the central portion.

Therefore, Applicants respectfully submit that claim 39 should be allowed.

**4. Claim 43**

In addition to the above mentioned, Gilman does not disclose, teach or suggest that the merchandising card comprises a plurality of openings.

Therefore, Applicants respectfully submit that claim 43 should be allowed.

**C. Claim 45**

Newly added independent claim 45 reads:

A container for displaying an item, comprising:

a merchandising card displaying graphics or indicia and having a first end and a second end wherein *the merchandising card detachably secures an item between the first end and second end;*

a first end cap comprising *a depression shape located within the walls of the first end cap to secure the first end of the merchandising card* and a second end cap comprising *a depression shape located within the walls of the second end cap to secure the second end of the merchandising card;* and

a central portion press fit coupled to the walls of the first and the second end caps.

*(Emphasis added).*

Applicants respectfully submit that the teachings of Gilman fail to disclose all aspects of the invention emphasized in the above claim. In particular, the teachings

of Gilman fail to disclose a depression shape located within the walls of the first end cap and second end cap to secure the first end and second end of the merchandising card, respectively. Gilman discloses an end wall 25 that holds the advertising material 14 in place. This does not disclose a depression shape for holding the merchandising card.

Additionally, Applicants respectfully submit that Gilman also fails to disclose the merchandising card detachably securing an item between the first end and the second end of the merchandising card. Gilman discloses a weight 15, which is not secured to the advertising material of Gilman. This does not disclose detachably securing an item for display between the first end and the second end of the merchandising card.

Therefore, since the teachings of *Gilman* fail to disclose all elements of independent claim 45, Applicants respectfully submit that independent claim 45 should be allowed.

**D. Claims 46-55**

Applicants respectfully submits that pending dependent claims 46-55 contain all features of the respective independent claim 45. Since independent claim 45 should be allowed, pending dependent claims 46-55 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**1. Claim 47**

HAYES SOLOWAY P.C.  
130 W. CUSHING ST.  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

In addition to the above mentioned, Gilman does not disclose that the transparent material comprises a thermoplastic.

Therefore, Applicants respectfully submit that claim 47 should be allowed.

**2. Claim 49**

In addition to the above mentioned, Gilman does not disclose protrusions on the end cap rims for engaging an opening in the end cap rims.

Therefore, Applicants respectfully submit that claim 49 should be allowed.

**3. Claim 51**

In addition to the above mentioned, Gilman does not disclose that each end cap rim further comprises a groove for accepting the central portion.

Therefore, Applicants respectfully submit that claim 51 should be allowed.

**4. Claim 55**

In addition to the above mentioned, Gilman does not disclose that the end caps are capable of supporting the central portion in an upright position.

Therefore, Applicants respectfully submit that claim 55 should be allowed.

**II. Response To Claim Rejections Based On Obviousness**

Claims 33-55 are not obvious in view of U.S. Patent No. 4,534,126 to Gilman (hereafter, "Gilman"), U.S. Patent No. 5,645,329 to Madock (hereafter "Madock"), U.S. Patent No. 3,306,266 to McCunney (hereafter "McCunney"), or a combination thereof.

HAYES SOLOWAY P.C.  
130 W. CUSHING ST.  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

In order for a claim to be properly rejected under 35 U.S.C. § 103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. *See e.g. In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Applicants respectfully submits that the combined teachings of the above references fail to disclose, teach, or suggest all elements of the preliminarily rejected claims for the reasons that follow.

Applicants respectfully submit that none of the above references disclose, teach, or suggest all elements of the new claims for the reasons that follow.

#### A. Claim 33

Newly added independent claim 33 reads:

A container for displaying an item comprising:

a first end cap comprising *a protrusion shape located within a rim of the first end cap* and a second end cap comprising *a protrusion shape located within a rim of the second end cap* both the first and second end cap having a cross section;

*a central portion press fit coupled to the first and the second end caps;*

a merchandising card comprising *a first end secured with the protrusion shape of the first end cap* and *a second end secured with the protrusion shape of the second end cap* and carrying graphics or indicia extending between and secured in position in the end caps wherein the merchandising card detachably secures an item between the first end and the second end.

*(Emphasis added).*

Applicants respectfully submit that the teachings of Madock fail to disclose, teach, or suggest the elements emphasized in the above claim. In particular, the teachings of Madock fail to disclose, teach, or suggest a central

HAYES SOLOWAY P.C.  
130 W. CUSHING ST.  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

portion press fit coupled to the first and the second end caps. Further, the teachings of Madock fail to disclose, teach, or suggest a merchandising card carrying graphics or indicia.

In rejecting claim 1, the Office Action reads:

Madock discloses a holder including a cap 12 and a cap 16. *A central portion 13 is situated between the two caps. A card 14 also extends between the two caps.* The central portion comprises protrusions to engage the opening in the end cap. Madock does not show indicia on element 14, but it is well known in the art to provide indicia on a card or container to illustrate the device or to provide additional information thereon.

(Emphasis added).

Applicants respectfully submit that neither the above referenced and emphasized portion of Madock nor the remaining portion of Madock disclose, teach, or suggest a central portion press fit coupled to the first and the second end caps.

The relevant sections of Madock read:

A compact disc case holder ... includes a bottom wall 12, side walls 13 and 14 and a top wall 16. ... *When the side walls 13 and 14 are thus mounted on the respective sides 28 and 38 of the bottom wall 12 and the top wall 16 is thus mounted on the side walls 13 and 14, a compact disk case holder 10 having a generally rectangular shape is thus formed.*

(Emphasis added).

Applicants respectfully submit that the above-cited sections and emphasized passages of Madock define a structure comprising walls, the structure having no independent central portion press fit coupled to the first and the second end caps. Madock discloses two sidewalls 14, which does not

HAYES SOLOWAY P.C.

130 W. CUSHING ST.  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567



disclose, teach, or suggest a central portion. Further, Madock defines a structural component of the rectangular shape, sidewall 14, rather than a merchandising card carrying graphics or indicia, extending between the bottom wall 12 and the top wall 16. Therefore, since the teachings of Madock fail to disclose, teach, or suggest the above-cited elements of independent claim 33, Applicants respectfully submit that independent claim 33 should be allowed.

Applicants respectfully submit that the teachings of McCunney in view of Gilman fail to disclose, teach, or suggest all aspects of the invention emphasized in the above claim. In particular, the teachings of McCunney in view of Gilman fail to disclose, teach, or suggest a protrusion shape on each or both the first end cap and second end cap for securing a first and second end of the merchandising card, respectively. McCunney discloses a receptacle 10 with a screwed-on cap 15. The cap 15 of McCunney does not disclose, teach, or suggest a protrusion shape on the end caps for securing an end of the merchandising card. Gilman fails to cure the deficiency. Gilman discloses an end wall 25 that holds the advertising material 14 in place. The combined teachings do not disclose, teach, or suggest protrusions for holding the merchandising card.

Therefore, since McCunney in view of Gilman fails to disclose, teach, or suggest all elements of independent claim 33, Applicants respectfully submit that independent claim 33 should be allowed.

HAYES SOLOWAY P.C.  
130 W. CUSHING ST.  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

**B. Claims 34-44**

Applicants respectfully submit that pending dependent claims 34-44 contain all features of the respective independent claim 33. Since independent claim 33 should be allowed, pending dependent claims 34-44 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**1. Claim 37**

In addition to the above mentioned, neither Madock nor McCunney in view of Gilman disclose, teach, or suggest protrusions on the end cap rims for engaging an opening in the end cap rims.

Therefore, Applicants respectfully submit that claim 37 should be allowed.

**2. Claim 39**

In addition to the above mentioned, neither Madock nor McCunney in view of Gilman disclose, teach, or suggest that each end cap rim further comprises a groove for accepting the central portion.

Therefore, Applicants respectfully submit that claim 39 should be allowed.

**3. Claim 43**

In addition to the above mentioned, neither Madock nor McCunney in view of Gilman disclose, teach, or suggest that the merchandising card comprises a plurality of openings.

Therefore, Applicants respectfully submit that claim 43 should be allowed.

HAYES SOLOWAY P.C.  
130 W. CUSHING ST.  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

**C. Claim 45**

Newly added independent claim 45 reads:

A container for displaying an item, comprising:

a merchandising card displaying graphics or indicia and having a first end and a second end wherein *the merchandising card detachably secures an item between the first end and second end;*

a first end cap comprising *a depression shape located within the walls of the first end cap to secure the first end of the merchandising card* and a second end cap comprising *a depression shape located within the walls of the second end cap to secure the second end of the merchandising card;* and

a central portion press fit coupled to the walls of the first and the second end caps.

*(Emphasis added).*

Applicants respectfully submit that the teachings of Madock fail to disclose, teach, or suggest the elements emphasized in the above claim. In particular, the teachings of Madock fail to disclose, teach, or suggest a central portion press fit coupled to the first and the second end caps. Further, the teachings of Madock fail to disclose, teach, or suggest a merchandising card carrying graphics or indicia.

In rejecting claim 20, the Office Action reads:

Madock discloses a holder including a cap 12 and a cap 16. *A central portion 13 is situated between the two caps. A card 14 also extends between the two caps.* The central portion comprises protrusions to engage the opening in the end cap. Madock does not show indicia on element 14, but it is well known in the art to provide indicia on a card or container to illustrate the device or to provide additional information thereon.

*(Emphasis added).*

HAYES SOLOWAY P.C.  
130 W. CUSHING ST.  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

Applicants respectfully submit that neither the above referenced and emphasized portion of Madock nor the remaining portion of Madock disclose, teach, or suggest a central portion press fit coupled to the first and the second end caps.

The relevant sections of Madock read:

A compact disc case holder ... includes a bottom wall 12, side walls 13 and 14 and a top wall 16. ... *When the side walls 13 and 14 are thus mounted on the respective sides 28 and 38 of the bottom wall 12 and the top wall 16 is thus mounted on the side walls 13 and 14, a compact disk case holder 10 having a generally rectangular shape is thus formed.*

(Emphasis added).

Applicants respectfully submit that the above-cited sections and emphasized passages of Madock define a structure comprising walls, the structure having no independent central portion press fit coupled to the first and the second end caps. Madock discloses two sidewalls 14, which does not disclose, teach, or suggest a central portion. Further, Madock defines a structural component of the rectangular shape, sidewall 14, rather than a merchandising card carrying graphics or indicia, extending between the bottom wall 12 and the top wall 16. Therefore, since the teachings of Madock fail to disclose, teach, or suggest the above-cited elements of independent claim 45, Applicants respectfully submit that independent claim 45 should be allowed.

Applicants respectfully submit that McCunney in view of Gilman fail to disclose, teach, or suggest all aspects of the invention emphasized in the above claim.

HAYES SOLOWAY P.C.  
130 W. CUSHING ST.  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

In particular, McCunney in view of Gilman fail to disclose, teach, or suggest a depression shape on each of the first end cap and second end cap for securing a first and second end of the merchandising card, respectively. McCunney discloses a receptacle 10 with a screwed-on cap 15. The cap 15 of McCunney does not disclose, teach, or suggest a depression shape on the end caps for securing an end of the merchandising card. Gilman fails to cure the deficiency. Gilman discloses an end wall 25 that holds the advertising material 14 in place. The combined teachings do not disclose, teach, or suggest a depression shape for holding the merchandising card.

Therefore, since McCunney in view of Gilman fails to disclose, teach, or suggest all elements of independent claim 45, Applicants respectfully submit that independent claim 45 should be allowed.

**D. Claims 46-55**

Applicants respectfully submit that pending dependent claims 46-55 contain all features of the respective independent claim 45. Since independent claim 45 should be allowed, pending dependent claims 46-55 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**1. Claim 49**

In addition to the above mentioned, neither Madock nor McCunney in view of Gilman disclose, teach, or suggest protrusions on the end cap rims for engaging an opening in the end cap rims.

HAYES SOLOWAY P.C.  
130 W. CUSHING ST.  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

Therefore, Applicants respectfully submit that claim 49 should be allowed.

**2. Claim 51**

In addition to the above mentioned, neither Madock nor McCunney in view of Gilman disclose, teach, or suggest that each end cap rim further comprises a groove for accepting the central portion.

Therefore, Applicants respectfully submit that claim 51 should be allowed.

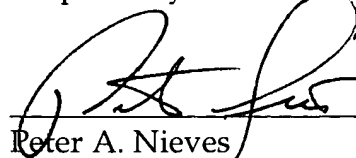
**III. Prior Art Made of Record**

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

**CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, the Applicants respectfully submit that all objections and rejections have been traversed, rendered moot and/or accommodated, and that new claims 33-55 are in condition for allowance. Favorable reconsideration and allowance of the present application and the presently pending claims are hereby courteously requested. If in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (603) 668-1400.

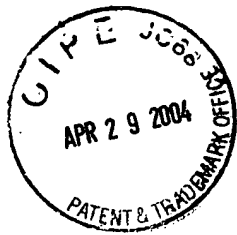
Respectfully submitted,



Peter A. Nieves  
Attorney for Applicants  
Reg. No. 48,173  
Customer No. 26,812

HAYES SOLOWAY P.C.  
130 W. CUSHING ST.  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567



Serial No. 09/976,418

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 27, 2004 at Manchester, New Hampshire.

By: Kristine Stevens  
Kristine Stevens

RECEIVED  
MAY 04 2004  
TECHNOLOGY CENTER R3700

HAYES SOLOWAY P.C.

130 W. CUSHING ST.  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567